

## REMARKS

Claims 1-9 were pending when this application was last examined. Claims 10-27 have been added. None of the pending claims have been amended. The title has been amended such that is clearly indicative of the invention to which the claims are directed. The specification has been amended to refer to the parent application of the present application. No new matter has been added. An unmarked version of the new paragraph and the pending claims is provided above. The new paragraph is also provided herewith in Attachment A. Newly added claims 10-27 are provided herewith in Attachment B.

### Election/Restriction

Applicant appreciates the Examiner's decision to vacate the Election of Species requirement.

### Priority

Applicant has amended the specification to refer to the parent application of the present application.

### Claim Rejections – 35 U.S.C. §103(a)

Claims 1-9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Applicant's Admitted Prior Art in view of U.S. Patent No. 5,362,955 issued to Haghiri-Tehrani.

To render a claim obvious under 35 U.S.C. § 103(a), the Examiner must establish a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness, the Examiner must establish three elements. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Claim 1 recites a "reel-deployable printed circuit board comprising: an elongated, flexible base board having opposite edges and a slit formed into it, the slit having an inner periphery defining a unit board within the flexible base board; and, at least a connection bar

connecting the unit board to the base board such that the unit board is pivotable on the connection bar relative to the base board.”

*The Third Element Of A Prima Facie Case Of Obviousness Has Not Been Established*

Applicant respectfully submits that the Examiner has not established the third element for a *prima facie* case of obviousness. That is, the Examiner has not established that the prior art references when combined teach or suggest all the claim limitations

The Examiner contends:

Haghiri-Tehrani teaches an elongated, flexible base board (Reference number 11) having a slit formed into it (See Figure 5), the slit having an inner periphery defining a unit board within the flexible base board (See Figure 5); and at least a connection bar connecting the unit board to the base board such that the unit board is pivotable on the connection bar relative to the base board (See Figure 5).

See Page 3 of January 17, 2002 Office Action (emphasis added).

Applicant respectfully disagrees. As shown in Fig. 5 of Haghiri-Tehrani, the unit board is connected to the base board by three bar areas 30. See Fig. 5 and Col. 6, lines 33-59. The three bar areas 30 connect the base board to the unit board such that the unit board is not pivotable on the connection bar relative to the base board, whereas Claim 1 requires “at least a connection bar connecting the unit board to the base board such that the unit board is pivotable on the connection bar relative to the base board.” Thus, Haghiri-Tehrani does not teach the limitation “at least a connection bar connecting the unit board to the base board such that the unit board is pivotable on the connection bar relative to the base board.” Furthermore, Haghiri-Tehrani does not suggest the limitation “at least a connection bar connecting the unit board to the base board such that the unit board is pivotable on the connection bar relative to the base board.”

Additionally, the purposes and uses of the present invention and the invention disclosed in Haghiri-Tehrani are completely different. The purpose of the three bar areas 30 in Haghiri-Tehrani is to increase punching precision. By contrast, the purpose of the “at least one connection bar” of the present invention is to decrease warpage of the unit boards. If the Haghiri-Tehrani embodiment were used on a reel-deployable printed circuit board, the card member would simultaneously warp with the standard card since the stress transmits directly

to the card member through the three bar areas that are disposed perpendicular and parallel to the reel direction.

For the reasons set forth above, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness. As a result, Applicant respectfully requests the Examiner to withdraw the rejection of Claim 1 and to allow this claim. Since Claims 2-9 depend from Claim 1, Applicant further requests the Examiner to withdraw the rejection of these claims and to allow these claims as well.

*The First Element Of A Prima Facie Case Of Obviousness Has Not Been Established*

Applicant respectfully submits that the Examiner has not established the first element for a *prima facie* case of obviousness. That is, the Examiner has not established that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to combine reference teachings.

The Examiner contends:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Applicant's Admitted Prior Art and Haghiri-Tehrani in order to have a flexible base board having a slit formed into it, the slit having an inner periphery defining a unit board within the flexible base board; and at least a connection bar connecting the unit board to the base board such that the unit board is pivotable on the connection bar relative to the base board.

See Page 3 of January 17, 2002 Office Action.

Applicant respectfully disagrees. The present invention is directed to a reel-deployed printed circuit board. By contrast, Haghiri-Tehrani is directed to an integrated circuit card having a severable mini chip card. Nowhere in Haghiri-Tehrani is there a discussion of reel-deployed printed circuit boards or the problems associated therewith. As such, one of ordinary skill in the art would not look to Haghiri-Tehrani when faced with the problems associated with reel-deployed printed circuit boards that are addressed by the present invention. Consequently, there is no suggestion or motivation, either in the Applicant's Admitted Prior Art or in Haghiri-Tehrani to combine the Applicant's Admitted Prior Art with Haghiri-Tehrani.

For the reasons set forth above, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness. As a result, Applicant respectfully

LAW OFFICES OF  
SEJVERN MORRILL  
MACPHERSON LLP  
25 METRO DRIVE  
SUITE 700  
SAN JOSE, CA 95110  
(408) 433-9200  
FAX (408) 433-7979

requests the Examiner to withdraw the rejection of Claim 1 and to allow this claim. Since Claims 2-9 depend from Claim 1, Applicant further requests the Examiner to withdraw the rejection of these claims and to allow these claims as well.

New Claims

Claims 10-27 have been added. Claims 10-27 include limitations similar to those discussed above in connection with Claim 1 and thus are allowable for at least the same reasons as discussed above in connection with Claim 1.

CONCLUSION

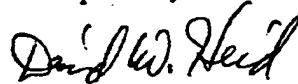
Applicant respectfully requests that the pending claims be allowed and the case passed to issue. Should the Examiner wish to discuss the Application, it is requested that the Examiner contact the undersigned at (408) 453-9200.

Express Mail Label No.:

EL 937 082 245 US

April 11, 2002

Respectfully submitted,



David W. Heid  
Attorney for Applicant  
Reg. No. 25,875

LAW OFFICES OF  
COURTNEY MORRILL  
MACPHERSON LLP  
25 METRO DRIVE  
SUITE 700  
SAN JOSE, CA 95110  
(408) 453-9200  
FAX (408) 453-7979